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JAN 14 2005

OFFICE OF PETITIONS

In re Reissue Application of:	:	JAN 14 2005
REUSER et al.	:	
Reissue Application No. 10/046,180	:	<b>OFFICE OF PETITIONS</b>
Filed: January 6, 2002	:	
Original Patent No. 6,118,045	:	<b>DECISION DENYING PETITION</b>
Issue Date: September 12, 2000	:	
For: LYSOSOMAL PROTEINS PRODUCED	:	
IN THE MILK OF TRANSGENIC ANIMALS	:	

This is a decision on the renewed petition under 37 CFR § 1.181 filed July 25, 2003, seeking acceptance of the above-identified reissue application in the absence of the signatures of all the inventors named in the above-identified patent, and in the absence of the consent of all the assignees of the above-identified original patent.

The petition is **DENIED**.

## BACKGROUND

The above-noted '045 patent names Reuser, Van der Ploeg, Pieper, and Verbeet as inventors, and pursuant to 35 U.S.C. § 152 and 37 CFR 3.81(c)(2) was granted to Pharming, Leiden University, Academic Hospital, and Erasmus University, as the multiple assignees of the entire right, title, and interest of all the named inventors.

The reissue application papers as filed included two unexecuted declarations, one naming Reuser, Van der Ploeg, and Verbeet as three of the four joint inventors named in the patent, and another naming Pieper as the fourth inventor, but disclaiming his inventorship and four unexecuted consents of the named assignees of the entire interest. The unsigned declaration stated that the error sought to be corrected by this reissue application is an asserted misjoinder of Pieper, who, by a conveyance recorded at the USPTO, has assigned his entire rights title and interest in the '045 patent to Pharming.

On March 18, 2002, the Office of Initial Patent Examination (OIPE) mailed a Notice of Missing Parts, indicating, *inter alia*, that the consent of all assignees was present, but had not been signed by all assignees, and that the declarations were likewise unsigned by the named inventors, and that these documents had to be executed.

In reply, on September 18, 2002, applicants filed a request for a four month extension of time, a reissue declaration naming only Reuser, Van der Ploeg, and Verbeet, and signed only by these named inventors, the written consent of Leiden University (the assignee of Verbeet's rights, title and interest), Academic Hospital (the assignee of Van der Ploeg's rights, title, and interest), and Erasmus University (the assignee of Reuser's rights, title, and interest), but lacked the consent of Pharming (the assignee of Pieper's rights, title, and interests), a statement under 37 CFR 3.73(b) signed on behalf of the aforementioned assignees of the part interest with the exclusion of Pharming, a petition under 37 CFR 1.47(a) seeking USPTO acceptance of this reissue application in the absence of Pieper's signature on the declaration, and a petition under 37 CFR 1.181 seeking USPTO processing of this reissue application in the absence of the consent of Pharming required by 37 CFR 1.172.

The petitions were dismissed in the decision of March 13, 2003. The decision noted that 37 CFR 1.47 was immaterial to the facts of this case, and included a Notice of Missing Parts that again required the consent of all the assignees of the original patent under 37 CFR 1.172, and noted that unless such were supplied the oath/declarations remained defective.

The instant renewed petition was filed July 25, 2003. The accompanying reply to the Notice still lacked the consent of Pieper's successor in title Pharming, and the oath/declaration still lacked Pieper's signature.

#### STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law, which...  
(A) shall govern the conduct of proceedings in the Office.

35 U.S.C. § 100(d) states

The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

35 U.S.C. § 116 states:

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

35 U.S.C. § 152 states:

Patents may be granted to the assignee of the entire interest of the inventor of record in the Patent and Trademark office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

35 U.S.C. § 251 states in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of

the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

35 U.S.C. § 252 states in pertinent part

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.:

35 U.S.C. § 256 states:

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

35 U.S.C. § 261 states in pertinent part:

Subject to the provisions of this title, patents shall have the attributes of personal property. Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

37 CFR 1.47(a) states:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

37 CFR 1.48(a) states:

(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. If the nonprovisional application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47

- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 CFR 1.48(h) states:

(h) Reissue applications not covered. The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

37 CFR 1.53(h) states:

Subsequent treatment of application--Nonprovisional (including continued prosecution) application. An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

37 CFR 1.172 states:

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), **and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter (emphasis added).**

(b) A reissue will be granted to the original patentee, his legal representative or assigns as the interest may appear.

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director, or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 3.54 states:

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

37 CFR 3.71(b) states:

Patents - assignee(s) who can prosecute. The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) A single assignee. An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) Partial assignee(s) together or with inventor(s). **All partial assignees**, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, **who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined** (emphasis added).

37 CFR 3.73 states in pertinent part:

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or

registration, unless there is an assignment.

(b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Commissioner. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.



37 CFR 3.81(c)(2) states:

If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

### OPINION

Petitioners (Leiden University, Academic Hospital of the Netherlands, and Erasmus University) seek reconsideration and ask that "a lack of consent of all assignees [the consent of Pharming is lacking from the record] be accepted for this reissue application." Petitioners assert that Baker Hughes v. Kirk, 921 F.Supp. 801, 38 USPQ2d 1885 (D.D.C. 1995) should not be considered binding precedent. Petitioners further assert that as the other three named inventors (Reuser, Van der Ploeg, and Verbeet) have sworn that they are the "sole inventors" of the claimed subject matter, Pieper had no actual rights in the claimed invention to convey to Pharming. As such, petitioners contend, the present reissue application does in fact have the consent of the assignee of the entire interest to correct the alleged misjoinder of Pieper. In the alternative, petitioners request that the Director suspend the rules in equity due to clinical testing of the claimed invention.

Unfortunately, since this reissue application seeks to extinguish the property rights of Pharming, this reissue application will not be accepted as complete in the absence of Pharming's consent to this reissue proceeding.<sup>1</sup>

The original patent was granted, pursuant to 35 U.S.C. § 152 and 37 CFR 3.81(c)(2), to the recorded, pursuant to 35 U.S.C. § 261, assignees of the entire interests of the four named inventors: Leiden University, Academic Hospital of the Netherlands, Erasmus University, and Pharming, and as such, all four assignees hold legal title to the patent. See Arachnid, Inc. v. Merit Industries, Inc., 939 F.2d 1574, 1577 n.2, 19 USPQ2d 1513, 1516, n.2 (Fed. Cir. 1991). Petitioners are reminded that the issuance of the original patent to the four co-assignees naming four co-inventors bears the statutory presumption of correctness. 35 USC § 282. Thus, Pharming, as Pieper's successor in title, per 35 USC 100(d), owns a *pro rata* undivided interest in the original patent, see Ethicon, Inc. v. United Sates Surgical Corp., 135 F.3d 1456, 1465, 45 USPQ2d 1545, 1552 (Fed. Cir 1998), cert.

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<sup>1</sup> As the court observed in In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977) "[s]ection 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure."

denied, 525 U.S. 923 (1998), and, it follows, in this reissue application. Pursuant to 37 CFR 3.54, it is determined that petitioners are but partial assignees of the original patent within the meaning of 37 CFR 3.71(b)(2), but are not the assignees of the entire interest in the original patent within the meaning of 37 CFR § 3.71(b)(2) and § 1.172, as there is concededly no showing on the record that individually or collectively, they are at this time the successors in title to the entire part interest of co-assignee Pharming.

Furthermore, the above-identified original patent remains in full force and effect unless (and until) a reissue patent is granted by the Director, and as such, no changes in the as-issued patent have been effectuated by the mere filing of this reissue application. See 35 U.S.C. § 252, first paragraph ("[t]he surrender of the original patent shall take effect upon the issue of the reissued patent...and every reissued patent shall have the same effect and operation in law...as if the same had been originally granted in the amended form"; Spectronics Corp. v. H.B. Fuller Co., Inc., 940 F.2d 631, 19 USPQ2d 1545 (Fed. Cir 1991) (court dismissing a declaratory judgment suit in that the mere filing of a reissue application by defendant did not raise a reasonable apprehension of suit in plaintiff and noting:

"[t]here is, however, no guarantee that the reissue patent will eventually issue. 37 C.F.R. § 1.178 (1990) ("[i]f a reissue be refused, the original patent will be returned to applicant upon his request"); see State Indus., Inc. v. A.O. Smith Corp., 751 F.2d 1226, 1236, 224 USPQ 418, 425 (Fed. Cir. 1985) (ultimate fate and legal effect of pending patent application is inherently uncertain)").

Thus, the mere filing of this reissue application by only three of the four assignees to whom the original patent was issued, and further, the mere assertion in the reissue declarations by three of the four named inventors that the fourth inventor was misjoined, does not operate at this time to amend the inventorship or the ownership of the original patent. As such, petitioners' artful pleading, due to the alleged misjoinder of Pieper who therefore had no rights to assign to Pharming, that Leiden University, Academic Hospital of the Netherlands, and Erasmus University constitute, collectively, the assignee of the entire interest of the original patent within the meaning of 37 CFR § 1.172, § 3.71(b), and § 3.73(b), must fall of its own weight, as no amendment to the ownership or to the inventorship of the as-issued patent has been effectuated by the mere filing of this reissue application. See 35 USC § 252; Spectronics, supra.

Indeed, while this same artful pleading was made by co- assignee Hydrill in support of the filing of its contested reissue application in the absence of the consent of co-assignee Baker Hughes, the court pointed to the procedures set forth in 35 U.S.C § 256 as controlling for the situation, where, as here, one party claims that it is the true holder of the patent and that another has been misjoined as an inventor therein. See Baker Hughes, 38

USPQ2d at 1892-93. Since this reissue application lacks the consent of named assignee Pharming, petitioners (Leiden University, Academic Hospital of the Netherlands, and Erasmus University) as the assignees of less than the whole interest in the patent are not entitled to force the filing and control the prosecution of this reissue application. See Commissioner of Patents v. Whiteley, 71 U.S. 522; 18 L. Ed. 335; 1866 U.S. LEXIS 902 (1866)(Court overturning a writ of mandamus ordering the Commissioner to subject to examination a reissue application filed by the assignee of only a part interest, as it lacked the consent of all the assignees that constituted the whole interest in the patent).<sup>2</sup>

Where, as here, a party, or parties (Leiden University, Academic Hospital of the Netherlands, and Erasmus University) is an owner of less than the whole interest in an application, that party or parties does not have the sole right to control prosecution of the application. See In re Goldstein, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988; see also In re Scold, 195 USPQ 335, 335 (Comm'r Pat. 1976); Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The procedures set forth in the regulations (e.g., 37 CFR §§ 1.172, 3.71(b), and § 3.73(b)) serve to assure that papers filed with the USPTO in an application or patent, much less papers that present an application for reissue of a patent, are submitted on behalf of the owners of the *entire* interest in the application(s) or patent. See Goldstein, 16 USPQ2d at 1964. Petitioners are reminded that this or any application will not be placed on the files for examination until all its required parts, that comply with all relevant regulations, are received in the USPTO. See 37 CFR 1.53(h).

Absent Pharming's consent within the meaning of 37 CFR 1.172 to the extinction of its *pro rata* property right in the original patent, the USPTO cannot properly further process this reissue application. See Baker Hughes, supra. Pharming, as a co-patentee and co-assignee, has a vested property right in the original patent that can be canceled, revoked, or annulled only by judicial proceedings that afford due process of law. See Iowa State University Research Foundation v. Sperry Rand Corp., 444 F.2d. 406, 410, 170 USPQ 374, 377 (4th Cir. 1971).<sup>3</sup> The USPTO may not permit *ex parte* proceedings before it to

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<sup>2</sup> The Court observed: "[t]he commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties. It required an answer before he could proceed further. His decision was against the appellant. Having resolved it in the negative, there was no necessity for him to look further into the case. Entertaining such views, it would have been idle for him to do so. The question was vital to the application, and its resolution was fatal, so far as he was concerned."

<sup>3</sup> Since a reissue application, once accepted, is subject to a reexamination, by requiring the consent of all assignees under 37 CFR 1.172, all owners thereby consent

extinguish a property right in the patent under the reissue statute (35 U.S.C. § 251) where such would evade the statutory safeguards of 35 U.S.C. § 256. See Baker Hughes, id.

Petitioners seek to distinguish Baker Hughes on the grounds that (1) a declaration has been filed herein by the allegedly three proper inventors, (2) the aforementioned three inventors have provided evidence that Pieper is not in fact a co-inventor of the claimed subject matter, and (3) Pieper has not acted on the opportunity to present evidence he is in fact a co-inventor. Nevertheless, the issuance of the original patent naming Reuser, Van der Ploeg, Pieper, and Verbeet as inventors creates a presumption that the four named inventors are the true and only inventors, see Hess v. Advanced Cardiovascular Sys., Inc., 106 F.3d 976, 980, 41 USPQ2d 1782, 1785-86 (Fed. Cir.), cert. denied, 117 S.Ct. 2459 (1997), and as such, the patent properly issued to Pharming, Leiden University, Academic Hospital, and Erasmus University, as the multiple assignees of the entire right, title, and interest of all the named inventors. The USPTO should not properly go beyond the threshold determination that the consent of Pharming is herein lacking, and then determine *ex parte*, and in the absence of the consent of Pharming, the inventorship herein, as such would circumvent the safeguards of § 256. See Baker Hughes, supra. To the extent that the three aforementioned features are different from the facts of Baker Hughes, they do not serve to undermine the clear instruction of Baker Hughes: the USPTO will not further process this reissue application in the absence of the consent of all four assignees that together constitute the whole interest in the patent. See Id.; Commissioner v. Whiteley, supra.

Petitioners further point to 35 U.S.C. § 116, paragraph 3, and § 256 in support of the proposition that the Director has the authority to correct an error in inventorship in both a patent application and a patent. Taking the latter statute first, the Director has no authority under § 256 to effect a change in inventorship of a patent unless all the named inventors consent in writing. See In re RCA Corp., 209 USPQ 1114 (Comm'r Pat. 1981). Here, as petitioners acknowledge, Pieper and Pharming have not consented to the change in inventorship. Rather, only if all the parties (all inventors and all assignees) are in consensus, can correction of inventorship in a patent be had on application to the

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on the record to the risk that the reissue application may be refused for other reasons. See e.g., In re Doyle, 483 F.2d 1385, 179 USPQ 227 (CCPA 1973) where the court affirmed the examiner's rejection of all the original patent claims and all the newly presented claims under 35 U.S.C. § 112, first paragraph. Correction of an alleged misjoinder by way of the provisions of 35 U.S.C. § 256, second paragraph, is a limited proceeding of lesser risk than reissue as the patent claims are not also subject to reexamination, yet all parties are afforded an opportunity to be heard.

Director; see § 256, first paragraph, and its implementing regulation 37 CFR 1.324. However, in the event consensus is not obtained, as herein, the second paragraph of 35 U.S.C. § 256 permits redress only in federal court "on notice and hearing of all parties concerned". MCV Inc v. King-Seeley Thermos Co., 870 F.2d 1568, 10 USPQ2d 1287, 1289 (Fed. Cir. 1989).; Pannu v. Iolab Corp., 155 F.3d 1344, 47 USPQ2d 1657 (Fed. Cir. 1998). Hence, the holding in Baker Hughes that reissue under § 251 should not be permitted, *ex parte*, to circumvent the statutory safeguards in § 256 regarding the extinction of property rights arising from an alleged misjoinder

Petitioners were apprised in the previous decision (at 3-4) that § 116, paragraph 2, and its promulgating regulation 37 CFR 1.47(a), are inapposite as they are properly invoked only to *protect* (not extinguish) the property right of a named joint inventor (or of his successor in title) by way of USPTO acceptance of a given application in the absence of that inventor's participation in the application. Here, petitioners contend that Pieper is not now and never was a joint inventor in the patent. Accordingly, it was untenable for petitioners to seek acceptance of this reissue application under 37 CFR 1.47(a) which promulgates 35 U.S.C. § 116, second paragraph, which requires, *inter alia*, that the signing inventor(s) consider the non-signing inventor to be a joint inventor in fact, while petitioners simultaneously contend that Pieper is not a joint inventor in fact. Rather, as admitted by petitioners, acceptance of the instant reissue application by the USPTO under the provisions of 35 U.S.C. 116, paragraph 2 and 37 CFR 1.47(a) would extinguish the property right of the co-assignee who has not consented to the filing. This is the antithesis of the protection of the property rights of a non-signing inventor, or his successor in title. But see Baker Hughes. Petitioners now rely upon the third paragraph of § 116, which is promulgated by 37 CFR 1.48(a), and assert that the Director has the authority thereunder to correct the inventorship herein. Petitioners appear to overlook that 37 CFR 1.48(h) states:

*Reissue applications not covered.* The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of a patent via a reissue application.

Nevertheless, the third paragraph of § 116 makes it clear that any amendment of the inventive entity of an application is discretionary with the Director, and is subject to such conditions as he prescribes ("the Director **may** permit the application to be amended accordingly, under such terms as he prescribes (emphasis added):" Note further that even in non-reissue applications where 37 CFR 1.48 is applicable, a statement (agreeing to, or at least not contesting, his deletion) is required from any inventor being deleted, and the agreement of his assignee, neither requirement having been met herein. See 37 CFR § 1.48(a)(2) and § 1.48(a)(3), which operate to protect the rights of the inventor and any

successor in title to the inventor's interest. In the instance where, as here, the application is for reissue of a patent, 37 CFR 1.172 (*i.e.*, "such terms as [the Director] prescribes") likewise operates to protect the interest of the assignee of any inventor being deleted, by requiring the assent of *all* assignees. Accordingly, § 116 authorizes, but does not compel, the Director to permit petitioners' requested amendment of the inventive entity herein to delete Pieper without Pieper's agreement, and thus to extinguish the property right of Pharming in this reissue application (and, ultimately, the patent, should this reissue be granted) without Pharming's express consent. Under the circumstances of this reissue application, the Director will exercise his discretion and will not accept this application seeking the requested amendment of the inventive entity in the absence of the consent of the assignees of the whole interest in the patent. See Commissioner v. Whiteley; Baker Hughes; 37 CFR 1.172.

WITH RESPECT TO WAIVER OF THE RULES:

In order for grant of a petition under 37 CFR 1.183, petitioners must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rules. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioners have not shown that either condition exists in this case.

While petitioners have filed the above-identified reissue application and persist in seeking USPTO acceptance thereof in the continuing absence of Pharming's consent, it is not incumbent on the USPTO to waive the applicable rules (*e.g.*, 37 CFR §§ 1.53(h), 1.172, 1.47(a), 3.71(b); and 3.73(b)) to the extent the rules may be waived in this instance, so as to accept this application. See Baker Hughes, supra; Commissioner v. Whiteley, supra. 37 CFR 1.183 should not be considered a panacea for tactical errors in prosecution. See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing or not filing papers). Circumstances resulting from petitioners' failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977). While the USPTO has indicated in MPEP<sup>4</sup> § 1410.01 that it is willing to

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<sup>4</sup> Manual of Patent Examining Procedure (MPEP) 8th Ed. Rev. 1 (March 2003). The MPEP has no binding force on the courts, but it commands notice as an official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in

consider a temporary waiver, in some instances, of the requirements of 37 CFR 1.172, the USPTO is only willing to consider temporary waiver to permit examination in those instances where the reissue application does not seek to extinguish a property right in the original patent has been filed by the assignee of the entire interest in the patent, a circumstance not present here. Even when a temporary waiver is favorably considered, however, the reissue application will not be allowed or passed to issue in the absence of the consent of all the assignees required by 37 CFR 1.172. See MPEP 1410.01 More relevant to the circumstances of this reissue application, the USPTO has indicated in MPEP 1412.04:

Where a reissue application does not seek to enlarge the scope of the claims the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under 37 CFR 1.172. **An assignee of the part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding.** See *Baker Hughes Inc v. Kirk*, 921 F.Supp. 801, 809, 38 USPQ2d 1885 (D.D.C. 1995) See 35 U.S.C. 251, third paragraph(bold emphasis added).

The USPTO will not normally consider an extraordinary remedy, when the patent statute and rules of practice already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). As petitioners were apprised in the decision of March 31, 2003, (at 4-5) petitioners may: (1) become the successor(s) in title to the entire part interest of Pharming in the original patent and thereafter file a new reissue application as the then true assignees of the entire interest within the meaning of 35 U.S.C. § 251 and 37 CFR 1.172; or (2) seek correction of inventorship in the patent under the provisions 35 U.S.C. § 256, first paragraph, and 37 CFR 1.324, if all named inventors and assignees are in consensus; or (3) if the consensus of all parties remains lacking, present the matter of alleged misjoinder to a court of competent jurisdiction under the provisions of § 256, second paragraph.

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procedural matters. In re Kaghan, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984); Ethicon v. Quigg, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988).

DECISION

The instant petition is granted to the extent that the decision of March 31, 2003, has been reconsidered but for the reasons given therein and also noted above is **denied**. The request that this reissue application be accepted in the absence of the consent of co-assignee Pharming required by 37 CFR 1.172 is **denied**. To the extent that petitioners seek acceptance of this reissue application under the provisions of 35 U.S.C. § 116, that request is likewise **denied**. To the extent that the petition can be considered as requesting waiver or suspension of the rules under 37 CFR 1.183, it is **denied**.

This decision may be considered a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.

The USPTO will not give further consideration or reconsideration to this matter.

This application is being returned to OIPE for further processing as an incomplete reissue application as it lacks the written assent of all assignees required by 37 CFR 1.172. This incomplete reissue application will not be placed on the files for examination.

Telephone inquiries related to this decision should be directed to Petitions Examiner Brian Hearn at (571) 272-3217.

A handwritten signature in cursive script, appearing to read "Charles Pearson", written in black ink.

Charles Pearson, Director  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy